

REMARKS

The present application was filed on March 5, 2002 with claims 1-27. During the course of previous responses, claims 8, 11 and 17-19 have been canceled. Thus, claims 1-7, 9, 10, 12-16 and 20-27 are pending, with claims 1, 12, 13, 20 and 23 being independent claims.

In the outstanding Office Action, the Examiner: (i) rejected claims 1-7, 9, 10, 12 and 23-27 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,815,081 to Motohashi (hereinafter “Motohashi”) in view of U.S. Patent No. 5,493,692 to Theimer et al. (hereinafter “Theimer”) in further view of U.S. Patent No. 6,687,497 to Parvulescu et al. (hereinafter “Parvulescu”); and (ii) rejected claims 13-16, 21 and 22 under 35 U.S.C. §103(a) as being unpatentable over Theimer in view of Parvulescu.

In this response, Applicants: (i) traverse the various §103(a) rejections for at least the following reasons; and (ii) add new claims 28-30 for consideration.

In the previous Office Action, the Examiner raised a §103(a) rejection based on the combination of Motohashi and Theimer. In their previous response dated March 16, 2005, Applicants amended pending independent claims 1, 12, 13, 20 and 23 to further clarify the subject matter of the invention. More particularly, Applicants amended independent claims 1, 12, 13 and 20 to indicate that context is also useable to automatically modify at least one of an operating mode associated with the signal receiving device and an alert indication mode associated with a signal intended for the signal receiving device, independent of at least an identity of the user of the signal receiving device, upon the signal receiving device being present in an environment that warrants mode modification. Independent claim 23 was amended to indicate that context is also useable to automatically modify an operating mode associated with the signal receiving device, independent of at least an identity of the user of the signal receiving device, upon the signal receiving device being present in an environment that warrants mode modification.

In the present Office Action, the Examiner appears to have added the Parvulescu reference to the combination of Motohashi and Theimer, in order to support the rejection of the newly added claim language. More particularly, the Examiner admits (at page 4) that Motohashi and Theimer fail

to disclose context that is independent of at least an identity of the user of the signal receiving device.

While, as previously argued, Applicants do not believe that the original Motohashi/Theimer combination teaches or suggests: (i) making an environment-appropriate determination based on context provided by an environment that the user is in and thus fails to teach or suggest delivery selection as it is related to appropriateness to the environment, or that context is also useable to automatically modify at least one of an operating mode associated with the signal receiving device and an alert indication mode associated with a signal intended for the signal receiving device, independent of at least an identity of the user of the signal receiving device, upon the signal receiving device being present in an environment that warrants mode modification (claims 1, 12, 13 and 20); or (ii) that context is also useable to automatically modify an operating mode associated with the signal receiving device, independent of at least an identity of the user of the signal receiving device, upon the signal receiving device being present in an environment that warrants mode modification (claim 23), Applicants respectfully assert herein that the addition of Parvulescu to the combination does not remedy these deficiencies.

One reason is because the combination of Motohashi, Theimer and Parvulescu fails to establish a prima facie case of obviousness under 35 U.S.C. §103(a), as specified in M.P.E.P. §2143.

As set forth in M.P.E.P. §2143, three requirements must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited combination must teach or suggest all the claim limitations. While it is sufficient to show that a prima facie case of obviousness has not been established by showing that one of the requirements has not been met, Applicants respectfully believe that none of the requirements have been met.

First, there is a clear lack of motivation to combine the references. For at least this reason, a prima facie case of obviousness has not been established.

As stated in Applicants' previous response, the Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions,

and cannot be dispensed with.” In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344.

In the present Office Action, at page 4, the Examiner provides the following statement to prove motivation to combine Motohashi and Theimer: “[i]t would have been obvious to a person of ordinary skill in the art at the time of [sic] the invention was made to include alert message to the receiver of Theimer et al. in the paging system of Motohashi with the motivation for doing so would allow [sic] the user with more privacy of receiving the message.”

Applicants once again submit that this statement is based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner again fails to identify any objective evidence of record in either Motohashi or Theimer which supports the proposed combination. Moreover, the present Office Action actually acknowledges, at page 3, that Motohashi fails to teach or suggest “evaluating context provide by the environment that the user is in and is an environment-appropriate . . . .” Thus, it is not understandable how there could be motivation coming from Motohashi, either expressly or impliedly, to modify Motohashi to make an environment-appropriate alert mode determination based on context provided by an environment that the user is in when it is acknowledged that Motohashi fails to teach or suggest evaluating context provide by the environment that the user is in and is an environment-appropriate.

Furthermore, the motivation to add Parvulescu to the combination is as faulty as the motivation to combine Motohashi and Theimer, if not more so.

In the present Office Action, the Examiner admits that Motohashi and Theimer fail to disclose context that is independent of at least an identity of the user of the signal receiving device. However, the Office Action cites Parvulescu for this feature. Parvulescu discloses a “small transmitter built into an electric system of an environment . . . [that] transmits a weak RF field capable of at least partially disabling a communication device . . . .” (see Abstract). The prime

example given includes a signal generated by the ABS braking system in a car that serves to switch off functionality of a cellphone of an occupant in the car while the car is moving.

The present Office Action at page 5 states that “it would have been obvious to a person of ordinary skill in the art at the time of the invention [sic] was made to include the context is [sic] independent of at least an identity of the user of the signal receiving device of Parvulescu et al. in the communication system of Motohashi and Theimer et al. with the motivation for doing so [sic] would enhance public safety.”

Applicants submit that this statement is also based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner again fails to identify any objective evidence of record in either Motohashi or Theimer or Parvulescu which supports the proposed combination.

Second, Applicants assert that there is no reasonable expectation of success in achieving the present invention through a combination of Motohashi, Theimer and Parvulescu. For at least this reason, a prima facie case of obviousness has not been established.

Despite the assertion in the present Office Action, Applicants do not believe that Motohashi, Theimer and Parvulescu are combinable since it is not clear how one would combine them. The present Office Action effectively admits that Motohashi fails to disclose context, and while it is asserted that Theimer discloses context, Theimer fails to disclose that the context is independent of the identity of the user of the signal receiving device.

However, Applicants point out that Theimer discloses “a method for selectively delivering electronic messages to an identified user or users in the system . . . based on the context of the system and the environment of the identified user” (see Abstract). Thus, it is quite clear that Theimer absolutely requires the identity of the user to operate at all. So, if Theimer is being relied upon in the cited combination to teach context and requires the identity of the user, then it is improper to combine a reference which discloses operation that does not require the identity of the user with Theimer. Nonetheless, this is what the present Office Action attempts to do.

Because the Examiner considers the Parvulescu signal transmitted from the ABS braking system to be “context” (which Applicants do not agree with and will further elaborate on below) and such “context” does not require the identity of the user, it is improper to combine such a method with

a context related system that requires the identity of the user (Theimer). How would Theimer work with Parvulescu, when Theimer requires the user identity and Parvulescu's contribution is the lack of user identity? There is no guidance provided in the Office Action. This is because they are functionally uncombinable.

Third, Applicants assert that even if combined, the Motohashi/Theimer/Parvulescu combination fails to teach or suggest all of the limitations of the claims. For at least this reason, a prima facie case of obviousness has not been established.

The cited combination fails to teach or suggest that "context is also useable . . . independent of at least an identity of the user of the signal receiving device," as in the claimed invention. The present Office Action asserts that the Parvulescu signal is context that is useable independent of at least an identity of the user of the signal receiving device. However, this is not accurate since the Parvulescu signal is not context and merely serves as a means of switching a cellphone on or off. Fundamentally, there is no context information created in Parvulescu. There also is no ability to compute on the information in Parvulescu. This is clear, for example, from the fact that Parvulescu never conveys the information that the vehicle is in motion to any other party. Only those devices local to the environment are aware of the signal. The fact that a device is operating under the signal is not shared with any other party, local or remote. Furthermore, the device knows nothing meaningful about its context from the Parvulescu signal. It only knows that it is receiving the signal and must change its behavior according to the predefined rules. The predefined rules cannot be changed in Parvulescu. Consequently, Parvulescu does not disclose context independent of the identity of the user as asserted by the examiner.

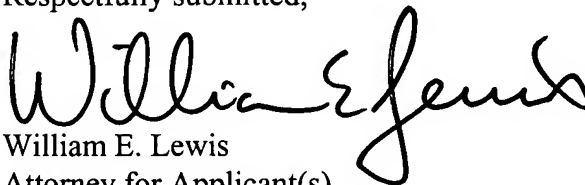
For at least these reasons, Applicants assert that the pending independent claims are patentable over the combination of Motohashi, Theimer and Parvulescu, as well as the combination of Theimer and Parvulescu (cited against claims 13-16, 21 and 22). It is also asserted that the dependent claims of the present application are patentable over the cited references not only for the reasons given above but also because such dependent claims also recite separately-patentable subject matter in their own right.

Applicants have added new claims 28-30 for consideration. It is asserted that these claims are patentable over the cited combinations not only for the reasons given above, but also because the

cited combinations fail to disclose that "at least a portion of the context is provided to at least another entity," as recited in new independent claim 28. The present specification illustratively describes such a feature, for example, at page 14, line 26, through page 15, line 3.

In view of the above, Applicants believe that the pending claims of the present application are in condition for allowance, and respectfully request withdrawal of the §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Lewis". The signature is fluid and cursive, with the first name "William" being the most prominent part.

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